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EXAMINER

TRUONG, THANHNGA B

ART UNIT	PAPER NUMBER
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2135

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/503,096	Applicant(s) AUGUST ET AL.	
	Examiner Thanhnga B. Truong	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the communication filed on May 08, 2007. Claims 1, 3-4, 6-30 are pending. Claims 2 and 5 are canceled by the applicant. At this time, claims 1, 3-4, and 6-30 are rejected.

Claim Objections

2. Claims 16-18 and 23-25 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims 14 and 15. See MPEP § 608.01(n). Accordingly, the claims 16-18 and 23-25 not been further treated on the merits.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3-4, 6-15, 17-18, 22-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Thrift (US 6,510,557).

a. Referring to claim 1:

i. Thrift teaches a method for delivering specific data related to a principal program, to one or more subscribers receiving said principal, program, said method comprising:

(1) embedding a watermark within said principal program (e.g., displaying a television program), first transmitting said principal program with the embedded watermark to said one or more subscribers (**see Figure 3 and column 4, lines 57-59 of Thrift**);

(2) decoding, at a central location not in physical proximity (according to applicant's specification, this central location is an off-site location, which is equivalent to a location on an information service provider, such as CNN, in **column 3, lines 20-25 of Thrift**) to a principal program (e.g., displaying a television program) presentation device for said one or more subscribers, said embedded watermark to determine the specific related data (e.g. a related internet web page) to be transmitted to said one or more subscribers (**column 3, lines 20-31 of Thrift**), the specific related data including at least one of an offer to said one or more subscribers, telephone number, World Wide Web address, coupon, and advertisement (**see Figure 1, element 28 – VBI decoder; and column 3, lines 20-40**); and

(3) second transmitting, in response to said decoded watermark, said specific data related to said principal program from the central location to said one or more subscribers through a communications network (**column 4, line 59 through column 5, line 9 of Thrift**).

b. Referring to claim 3:

i. Thrift further teaches:

(1) wherein said decoding step further comprises the steps of: receiving said principal program at a the central location (**column 3, lines 27-29 of Thrift**).

c. Referring to claim 4:

i. This claim has limitations that is similar to those of claim 1, thus it is rejected with the same rationale applied against claim 1 above.

d. Referring to claim 14 and 15:

i. These claims consist a communications system for delivering specific data related to a principal program, to one or more subscribers receiving said principal program to implement claim 1, thus they are rejected with the same rationale applied against claim 1 above.

e. Referring to claim 6:

i. Thrift further teaches:

(1) wherein said decoding step further comprises the steps of: receiving said principal program at a-the central location (**column 4, line 59 through column 5, line 9 of Thrift**); and in response to said decoded watermark, transmitting said specific data related to said principal program to a receiving device associated with said one or more subscribers through a communications network (**column 4, line 59 through column 5, line 9 of Thrift**).

f. Referring to claim 7:

i. Thrift further teaches:

(1) wherein said watermark includes a pointer to said specific related data stored in a database, further comprising the step of retrieving said specific data from said database prior to said transmitting step (because in Thrift's invention, Web address is a "pointer" to data stored in a server somewhere on the Internet and the Web page is retrieved before it is sent to the television receiver of the subscriber).

g. Referring to claim 8:

i. Thrift further teaches:

(1) wherein said watermark comprises said specific related data (e.g. a related internet web page).

h. Referring to claim 9:

i. Thrift further teaches:

(1) wherein said central location is a re-broadcaster of said principal program to said one or more subscribers (according to applicant's specification, this central location is an off-site location, which is equivalent to a location on an information service provider, such as CNN, in **column 3, lines 20-25 of Thrift**).

i. Referring to claims 10-12:

i. These claims have limitations that is similar to those of claim 9, thus it is rejected with the same rationale applied against claim 9 above.

j. Referring to claim 13:

i. Thrift further teaches:

(1) appending demographic data to said secondary specific related data prior to said transmitting step, wherein said transmitting said specific related data includes transmitting said demographic data **(column 4, lines 40-41 of Thrift)**.

k. Referring to claim 17:

i. Thrift further teaches:

(1) wherein said delivery means for delivering said specific related data is an IP server and said receiving device is an Internet enabled application running on a web enabled device associated with said one or more subscribers **(see Figure 1 and more details in column 2, lines 37-43 of Thrift)**.

l. Referring to claim 18:

i. Thrift further teaches:

(1) wherein said delivery means for delivering said specific related data is a radio transmitter (e.g., satellite transceiver) **(column 1, line 65 through column 2, line 1; and column 2, line 41-42 of Thrift)**.

m. Referring to claim 22:

i. Thrift further teaches:

(1) wherein said receiving device is a remote control device **(column 2, line 65 of Thrift)**.

n. Referring to claim 23:

i. Thrift further teaches:

(1) wherein said delivery means for delivering said specific related data is a television broadcast transmitter **(column 2, lines 45-51 of Thrift)**.

o. Referring to claim 24:

i. Thrift further teaches:

(1) wherein said delivery means for delivering said specific related data is a set top box **(see Figure 1, element 10)**.

p. Referring to claim 25:

i. Thrift further teaches:

(1) a transmitter for transmitting said principal program with said watermark embedded therein from a point of origin to a destination (**column 1, line 65 through column 2, line 1; and column 2, line 41-42 of Thrift**).

q. Referring to claim 26:

i. Thrift further teaches:

(1) delivery means for delivering said principal program to said one or more subscribers (**see Figure 1 and more details in column 2, lines 37-43 of Thrift**).

r. Referring to claim 27:

i. Thrift further teaches:

(1) wherein the principal program presentation device is at least one of an audio device and a video device (**column 2, lines 56-57 of Thrift**).

s. Referring to claims 28-30:

i. These claims have limitations that is similar to those of claim 27, thus it is rejected with the same rationale applied against claim 27 above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 16 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thrift (US 6,510,557), and further in view of Mitchell et al (US 6,108,406).

a. Referring to claim 16:

i. Thrift teaches a communication system for delivering specific data related to a principal program (e.g., the television program) using Java television platform (JTVP), which is the server, however Thrift is silent on the capability of using

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ADSI server (which could be implemented by JTVS server). On the other hand, Michell teaches:

(1) wherein said delivery means for delivering said specific related data in an ADSI server and said receiving device is an ADSI device **(column 2, lines 4-19 of Michell)**.

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Thrift with the teaching of Michell to download computer network information to an ADSI feature telephone **(column 1, lines 15-16 of Michell)**.

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Thrift with the teaching of Michell to process into a form suitable for download to an ADSI phone memory slot whereupon the information may be read by the user on the phones display screen (column 3, lines 25-27 of Michell).

b. Referring to claims 19-21:

i. The combination of teaching between Thrift and Michell teaches the claimed subject matter. Thrift and Michell further teaches:

(1) wherein said receiving device is an FM radio receiver **(column 2, line 58-59 of Michell)**; wherein said receiving device is a wireless telephone **(column 2, line 54 of Michell)**; wherein said receiving device is a pager **(column 2, line 54, element 12 can be a pager)**.

Response to Arguments

Applicant's arguments filed May 08, 2007 have been fully considered but they are not persuasive.

The newly added limitation in claims 1, 4, 14, and 15 still read on by Thrift. In fact, according to applicant's specification, this central location is an off-site location,

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which is equivalent to a location on an information service provider, such as CNN, in column 3, lines 20-25 of Thrift.

The Office Action is a Non-Final, since there are some issues with claim objection as well as new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

/Thanhnga B. Truong/

Primary Examiner, Art Unit 2135

TBT

March 20, 2008